

ADMINISTRATIVE PANEL DECISION

Swedish Match North Europe and Philip Morris International, Inc. v. matthew bourke, Matthews stock images

Case No. D2024-3231

1. The Parties

The Complainants are Swedish Match North Europe, Sweden and Philip Morris International, Inc., United States of America (“United States”), represented by D.M. Kisch Inc., South Africa.

The Respondent is matthew bourke, Matthews stock images, Australia.

2. The Domain Name and Registrar

The disputed domain name <buyzyn.shop> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 6, 2024. On August 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 13, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on August 14, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on August 16, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Commencement of Panel Appointment Process on September 6, 2024.

The Center appointed Luca Barbero as the sole panelist in this matter on September 26, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainants are Swedish Match North Europe AB (hereinafter, “the first Complainant”) and its parent company Philip Morris International Inc. (hereinafter, “the second Complainant”).

Acquired by the second Complainant in May 2022, the first Complainant was originally founded in 1992, and is specialized in the manufacturing, marketing, and sale of smoke-free tobacco products, such as snus and nicotine pouches.

One of such products is the ZYN nicotine pouch brand, first launched in the United States in 2016. Today, the ZYN nicotine product is available in key cities in around 15 markets across the world.

The first Complainant is the owner, amongst others, of the following trademark registrations:

- International trademark registration No. 1421212 for ZYN (word mark), registered on April 18, 2018, in class 34;
- Australian trademark No. 2318846 for ZYN (word mark), registered on August 07, 2023, in class 34;
- European Union Trade Mark No. 015272487 for ZYN (word mark), registered on July 8, 2016, in class 34;
- European Union Trade Mark No. 017579939 for ZYN (semi-figurative mark), registered on March 23, 2018, in class 34;
- International trademark registration No. 1456681 for ZYN (semi-figurative mark), registered on December 27, 2018, in class 34.

The disputed domain name <buyzyn.shop> was registered on April 4, 2024, and resolves to a website prominently featuring the ZYN mark and the wording “ZYN AUSTRALIA”, and offering purported ZYN products for sale.

5. Parties’ Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainants contend that the disputed domain name <buyzyn.shop> is confusingly similar to the trademark ZYN in which the Complainants have rights as it reproduces the trademark in its entirety with the mere addition of the descriptive term “buy” and the generic Top Level Domain (“gTLD”) “.shop”.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainants state that the Respondent has not been licensed or otherwise permitted to use any of the Complainants’ trademark or register a domain name incorporating the ZYN mark.

The Complainants also assert that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name and that the Respondent is not an authorized distributor or reseller of the ZYN nicotine products.

The Complainants submit that the website available at the disputed domain name does not meet the requirements set out in the leading case *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) to conclude that the use of a manufacturer's trademark as a domain name by a reseller could be deemed a "bona fide" offering of goods or services since i) the disputed domain name in itself suggests an affiliation with the Complainants and their ZYN mark; ii) the Respondent has prominently published the ZYN mark and official product images without authorization, whilst falsely claiming copyright of all material published on the website; and iii) the website includes no information regarding the identity of the website operator, which is only identified as "ZYN AUSTRALIA", generating the false impression of an official commercial relationship between the website and the Complainants.

With reference to the circumstances evidencing bad faith, the Complainants indicate that considering i) the Respondent started offering the Complainants' ZYN nicotine products immediately after registering the disputed domain name; and ii) the term "zyn" is purely an imaginative term and unique to the Complainants, and is not commonly used to refer to tobacco products or electronic devices, it is beyond the realm of reasonable coincidence that the Respondent chose the disputed domain name, without the intention of invoking a misleading association with the Complainants.

The Complainants also submit that the Respondent clearly registered and used the disputed domain name with the intention of attracting, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainants' ZYN mark as to the source, sponsorship, affiliation, or endorsement of its website.

The Complainants further state that the fact that the Respondent used a privacy protection service to hide its true identity in the WhoIs records may in itself constitute a factor indicating bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainants must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainants have rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainants' trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Indeed, the Complainants have provided evidence of ownership of valid trademark registrations for ZYN.

The entirety of the mark is reproduced in the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other term “buy” may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The applicable TLD in a domain name, such as the gTLD “.shop” in this case, is viewed as a standard registration requirement and is thus disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), sections 1.11.1.

Therefore, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds that the Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants’ prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

According to the evidence on record, there is no relationship between the Complainants and the Respondent, and the Complainants have not authorized the Respondent to register or use its trademark or the disputed domain name. Moreover, there is no element from which the Panel could infer a Respondent’s right over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

Furthermore, there is no evidence of use of the disputed domain name by the Respondent in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use without intention to misleadingly divert the consumers or to tarnish the Complainants’ trademark.

Indeed, as highlighted above, the disputed domain name has been pointed since its registration to a website publishing the Complainants’ ZYN mark and the wording “ZYN AUSTRALIA” in a prominent position and offering purported ZYN products for sale, without providing any information about the website operator nor any disclaimer of non-affiliation with the Complainants. The Panel finds that such use does not meet the Oki data requirements for a reseller or distributor to be making a bona fide offering of goods or services under a domain name corresponding to the complainant’s trademark. Indeed, the Respondent has failed to accurately and prominently disclose its lack of relationship with the trademark holder and the contents of the website appear to be designed to generate the impression that it is operated by the Complainants or one of their affiliated entities. [WIPO Overview 3.0](#), section 2.8.

Therefore, the Panel finds the second element of the Policy has also been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel finds that, in light of i) the prior registration and use of the trademark ZYN in connection with the Complainants' nicotine pouches since 2016; ii) the distinctiveness of the ZYN mark for nicotine products; iii) the composition of the disputed domain name, encompassing the Complainants' ZYN mark with the descriptive term "buy"; and iv) the content of the website published at the disputed domain name, featuring the Complainants' ZYN mark and images of ZYN products, the Respondent was clearly aware of the Complainants' trademark rights and registered the disputed domain name to target the Complainants' trademark.

In view of the redirection of the disputed domain name to the website described above, reproducing without authorization the Complainants' ZYN mark and offering purported ZYN products for sale, failing to disclose the lack of affiliation with the Complainants and displaying the wording "ZYN AUSTRALIA" which suggests an affiliation with the Complainants, the Panel finds that the Respondent intentionally attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainants' trademark as to the source, sponsorship, affiliation or endorsement of its website and the products offered therein, according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainants have established the third element of the Policy as well.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <buyzyn.shop> be transferred to the Complainants.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: October 10, 2024